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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,674	02/02/2001	Timothy M. Richardson	1960.30 DIV. I	7351
27160	7590	10/28/2004	EXAMINER BARTH, VINCENT P	
PATENT ADMINSTRATOR KATTEN MUCHIN ZAVIS ROSENMAN 525 WEST MONROE STREET SUITE 1600 CHICAGO, IL 60661-3693			ART UNIT 2877	PAPER NUMBER

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,674

Applicant(s)

RICHARDSON, TIMOTHY M.

Examiner

Vincent P. Barth

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-49 is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0201</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections under §103 Double Patenting & Basis for Double Patenting Rejection

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-26 are rejected under the judicially created doctrine of *obviousness-type double patenting* as being unpatentable over Claim 1 of Richardson, U.S. Pat. No. 6,381,013 (30 Apr. 2002), in view of "Nanofabrication and Biosystems", H. Hoch, et al., Cambridge University Press, pg. 126, para. 8.2.1 (1996), which rejection may be traversed by a Terminal Disclaimer, as discussed above.

4. Referring to instant Claims 14-26, Richardson claims a test slide comprising a substrate, a test pattern on said substrate comprising at least a diffraction grating and a scale system, and a locating pattern formed on said substrate to assist the observer in locating the test pattern, said test pattern including a first and second diffraction grating being orthogonally oriented to said second pattern, and said scales being orthogonal to each other (Claim 1, col. 18, lns. 35-49). Richardson Claim 1 does not explicitly discuss the method of making such patterns and scales, however, conventional methods of making such patterns and scales are set forth in the Hoch reference (Hoch, pg. 126, para. 8.2.1) to include metalization procedures, such as the application of aluminum films, and etching (including nanolithography), which is conventionally known to be accomplished by means such as electromagnetic radiation beams (i.e., energy beams), particle beams (i.e., energy beams), as well as chemical etching. In the context of the disclosure, those of

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ordinary skill in the art reading the Hoch reference would understand the conventional methods of metalization and etching discussed herein. Accordingly, the methods of producing the slide with a test pattern, scales, and locating pattern as recited in instant Claims 14-26 would have been obvious to those skilled in the art at the time of the invention, based on the Richardson reference in view of the Hoch reference.

Allowable Subject Matter

5. Claims 39-49 are allowable, since the prior art references, either considered alone or in combination, do not disclose or render obvious the limitations set forth therein.

6. Referring to Claim 39, the prior art references, either considered alone or in combination, do not disclose or render obvious the limitations whereby a method of forming a test slide comprises forming a master test pattern on an information carrier for an injection molding device, said test pattern including patterns of known size and shape, inserting the information carrier into said injection molding device, cycling the injection molding device to inject liquefied resin into contact with the information carrier to form said test pattern in one surface, in combination with the remaining limitations in the claim. Claims 40-48 are allowable based on their dependency upon the claim from which each is dependent. Referring to Claim 49, the prior art references, either considered alone or in combination, do not disclose or render obvious the limitations whereby a method of forming a test slide comprises forming a master test pattern on an information carrier for a mold, said test pattern including patterns of known size and shape, inserting the information carrier into a mold, adding a substrate material to said mold

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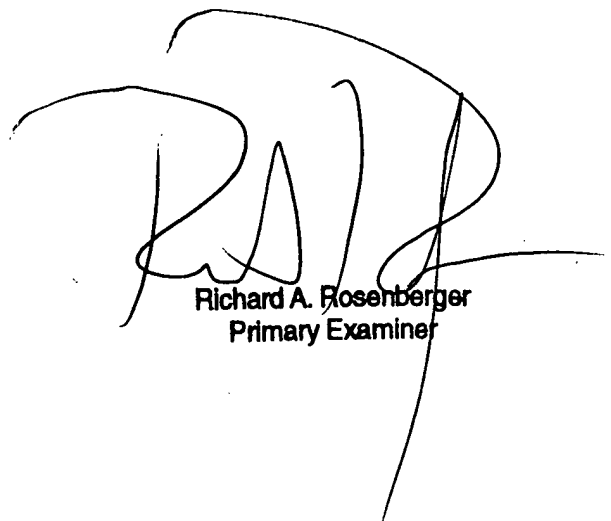
to contact said information carrier to form said test pattern in one surface, in combination with the remaining limitations in the claim.

Comments

7. The listing of references in the Specification is not a proper information disclosure statement, as Applicant has set forth such references on page 2 in the Specification of the instant Application. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states that the list may not be incorporated into the specification but must be submitted in a separate paper. Applicant must provide copies of such references prior to, or concurrent with, the reply to the instant Office Action.

CONCLUSION

8. Applicant's Claims 14-26 are rejected based on the reasons set forth above.
9. Applicant's Claims 39-49 are allowable based on the reasons set forth above.
10. Any inquiries concerning this communication from the Examiner should be directed to Vincent P. Barth, whose telephone number is 571-272-2410, and who may be ordinarily reached from 9:00 a.m. to 5:30 p.m., Monday through Friday. The fax number for the group before final actions is 703-872-9306.
11. If attempts to reach the Examiner prove unsuccessful, the Examiner's supervisor is Gregory J. Toatley, Jr., who may be reached at 571-272-2800, ext. 77.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard A. Rosenberger
Primary Examiner